REMARKS

Claims 26, 36-39, 43, and 45 have been amended. None of these claim amendments were done in response to any rejections or to overcome any prior art. Claims 26-45 are currently pending in the application.

The Examiner objected to Claims 43 and 44. Claim 43 has been amended to remove the "awkwardness" of the claims.

The Examiner rejected Claims 26-28, 34-37, and 41-45 under 35 USC § 102(e) as being anticipated by Masuda et al. (USPN 5,978,041; hereinafter "Masuda"). The Examiner rejected Claims 29-33 and 38-40 under 35 USC § 103(a) for being unpatentable over Masuda in view of Lagoni (USPN 5,204,748). These objections and rejections are respectfully traversed and Applicant requests reconsideration of the application.

102(e) Rejection

In order for a reference to anticipate an invention, each and every element of the claimed invention must be found in a single reference. "Moreover, it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 USPQ2d 1461, 1462 (Bd Pat App & Inter 1990). Applicant respectfully submits that Masuda does not anticipate Applicant's claimed invention because Masuda does not teach or disclose each and every element of the claimed invention.

In addition, the MPEP states in Section 2131.01 that the "identical invention must be shown in as complete detail as is contained in the … claim. The elements must be arranged as required by the claim…". Applicant respectfully submits the Examiner is

picking various elements from <u>Masuda</u> and applying those elements to Applicant's claims without considering the construction of Applicant's claims.

Independent claim 26 recites, in relevant part, "a host computer system for running an application program", "a processor device for automatically generating a window control signal in response to said application program", and "generating a window information signal in response to said window control signal". Nothing in <u>Masuda</u> teaches "a host computer system for running an application program" and "a processor device for automatically generating a window control signal in response to said application program".

The Examiner argues <u>Masuda</u> teaches this element in lines 59-63 in column 36, in lines 25-32 in column 37, in lines 3-10 in column 38, and in Figure 48. Applicant notes lines 59-67 in column 36 state the following:

> In the drawing [Figure 41], a program of the CPU circuit 34 as well as the picture data A are stored in ROM 3305 and the CPU circuit 34 performs processes such as setting of a composition area and execution of various operations on the basis of this program. In this case, the CPU circuit 34 sets the brightness level of the composition portion by software operation and by doing this, the hardware configuration becomes simpler than that of the embodiment shown in FIG. 31.

Lines 25-32 in column 37 state the following:

> FIG. 43 is a block diagram showing the seventeenth embodiment of the image display system and image display of the present invention. Numeral 3106 indicates an external input means, 3107 an input terminal, 3202 a specific area brightness conversion means, and 3405 an ROM and the same numeral is assigned to each of the parts corresponding to those shown in FIG. 31 so as to omit duplicated explanation.

Page 9 of 13

And lines 3-10 in column 38 state the following:

> FIG. 48 is a block diagram showing the eighteenth embodiment of the image display system and image display of the present invention. Numeral 350 indicates a picture display means, 351 a picture signal output means, 352 an interface, 3103 a picture composition means, and 3104 a CPU circuit and the same numeral is assigned to each of the parts corresponding to those shown in FIG. 43 so as to omit duplicated explanation.

Applicant respectfully submits these three paragraphs do not disclose or teach "a host computer system for running an application program" and "a processor device for automatically generating a window control signal *in response to said application program*". Lines 63-65 in column 36 do state the CPU sets the brightness level of the composition portion by software operation. However, this is not the same as "a host computer system for running an application program" and "a processor device for automatically generating a window control signal *in response to said application program*". Masuda is not generating a signal in response to the "software operation." Instead, this section of Masuda teaches *setting* the brightness level *by* software operation.

Applicant notes Figure 48 does show a "control signal" being provided to display means 350. However, the description of Figure 48 does not disclose how and why the control signal is generated. The description of the control signal is limited to "... a control signal passing through the interface 352 are supplied to the picture display means 350 from the picture signal output means 351." (see col. 38, lines 19-22). This brief description does not teach "a host computer system for running an application program" and "a processor device for automatically generating a window control signal *in response to said application program*".

Independent claim 26 also recites "generating a window information signal in response to said window control signal". Nothing in Masuda teaches "generating a

window information signal in response to said window control signal". The Examiner argues Masuda teaches this element in the timing signal key (Key) shown in Figure 52 and in lines 61-67 in column 39. Lines 61-67 state the following:

> In FIG. 52, when composition position data is inputted from the input terminal 3254, it is supplied to the timing generator 355 together with a synchronizing signal of the picture signal Video1 and a dot clock signal and a timing signal key of the composition position of the picture B which is the same as the timing signal key shown in FIG. 51 is generated. The change-over switch 3115 *is controlled by this timing signal key.* (emphasis added)

Applicant respectfully submits nothing in this paragraph discloses or teaches "generating a window information signal in response to said window control signal". It is not clear what signal in Figure 52 the Examiner believes corresponds to the window control signal. Initially the Examiner argues the "control signal" shown in Figure 48 corresponds to the window control signal. But Figure 52 does not include the "control signal" from Figure 48.

The Examiner does indicate the timing signal key (Key) in Figure 52 corresponds to Applicant's window information signal. However, the description of Figure 52 clearly states the timing signal key (Key) controls the change-over switch. The timing signal key is not received by a display control device that receives both a video signal and the window information signal and processes the video signal in response to the window information signal, as claimed in Applicant's claim 26.

The statements above regarding independent claim 26 also apply, in whole or in part, to independent claims 36, 43, and 45. Therefore, Applicant submits all of the independent claims are not anticipated by Masuda, and respectfully requests allowance of such claims.

Claims 27, 28, 34, and 35 depend from independent claim 26. Claims 37, 41, and 42 depend from independent claim 36. And claim 44 depends from independent claim 43. Since Masuda does not anticipate independent claims 26, 36, and 44, Applicant submits Masuda does not anticipate dependent claims 27-28, 34-35, 37, 41, 42, and 44.

103(a) Rejection – Masuda and Lagoni

The Manual of Patent Examining Procedure (MPEP) states the following in Section 2142:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicant submits that the combination of these two references does not render Applicant's claimed invention obvious, since the combination of references does not meet any of the three basic criteria listed above. The discussion below, however, will be limited to the third condition.

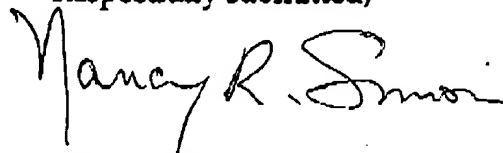*Combination of References Does Not Teach all Claim Limitations*

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03. Applicant submits the combination of Masuda and Lagoni does not teach all of the claim limitations in Applicant's claims.

Page 12 of 13

Claims 29-33 depend from independent claim 26, and claims 38-40 depend from independent claim 36. Applicant's statements with respect to Masuda apply to this rejection as well. Furthermore, the combination of Lagoni with Masuda does not teach or suggest all of the claims limitations in independent claims 26 and 36. If an independent claim is not rendered obvious by prior art, then any claim depending from the independent claim is not obvious. In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988) (see also M.P.E.P. § 2143.03). Therefore, Applicant respectfully submits claims 29-33 and 38-40 are not obvious in view of the combination of Masuda with Lagoni.

In light of the amendments and discussion above, Applicants believe that all claims currently remaining in the application are allowable over the prior art, and respectfully requests allowance of such claims.

Respectfully submitted,

Date: February 2, 2004

Nancy R. Simon
Attorney for Applicant
Reg. No. 36,930
Simon & Koerner LLP
10052 Pasadena Avenue, Suite B
Cupertino, California 95014
direct dial (408) 873-3941; fax (408) 873-3945